REMARKS

In the Office Action[1] mailed March 28, 2005, the Examiner rejected claims 1, 7, 8, 12, and 24 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; rejected claim 7 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. US 2002/0077082 to Cruickshank ("Cruickshank"); rejected claims 1-3, 5, 8-11, 12, 16, 17, 22, and 23 under 35 U.S.C. § 103(a) as unpatentable over Cruickshank in view of U.S. Patent Application Publication No. US 2002/0076027 to Bernnan et al. ("Bernnan"); and rejected claims 24 and 25 under 35 U.S.C. § 103(a) as unpatentable over Bernnan in view of Cruickshank.

In this Reply, Applicants have amended claims 1, 5, 7, 8, 12, 16, 17, and 24. Claims 1-3, 5, 7-12, 16, 17, and 22-25 are currently pending. No new matter has been added. Support for the amendments may be found in the specification, for example, at paragraphs [029], [043] and [044].

A.   Rejections Under 35 U.S.C. § 112

Applicants respectfully traverse the rejection of claims 1, 7, 8, 12, and 24 under 35 U.S.C. § 112, first paragraph, because the original disclosure provides adequate support for the claims. According to the Examiner, "the claimed limitations of the above claims lack support in the original disclosure and are considered new matter (claims 1, 8, 12, 24: the SCP including an identifier of a calling party and a voice mail message and a claim 7: a voice-mailbox)." (Office Action, page 2.) Applicants respectfully disagree for at least the reasons that follow.

As to claims 1, 8, 12, and 24, support for a service control point (SCP) may be found at least in Figure 6 and in paragraphs [065]-[068] of the specification. In addition, claim 1 recites, among other things, "receiving a first message from an SCP in the

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[1] As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence in this Response as to assertions by the Examiner in the Office Action or certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicants that such assertions are correct or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

telephone network at the at least one gateway device, *the first message including* an identifier of the calling party and the voice mail message." Therefore, contrary to the Examiner's interpretation, "an identifier of the calling party and the voice mail message" are recited as being included in the "first message" and not recited as being included in the SCP. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 8, 12, and 24 under section 112, first paragraph.

As to claim 7, Applicants could find no reference to a "voice-mailbox" *per se* in the claim. However, Applicants believe the Examiner may be referring to the recitation of "voice- mailbox owner" in the preamble of claim 7 (which is the only instance where "voice-mailbox owner" appears in its hyphenated form). Although Applicants see no practical difference between the hyphenated and non-hyphenated formulations, Applicants have amended claim 7 to remove the hyphen between "voice" and "mailbox," to conform to the usage in the claims. Support for the concept of a "voice mailbox owner" may be found at least on paragraphs [072]-[074] of the specification and the original version of claim 7 as filed. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 7 under section 112, first paragraph.

B.   Rejections Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claim 7 under 35 U.S.C. § 102(e) for at least the reason that Cruickshank fails to disclose every claim element. For example, claim 7 recites, among other things, "determining that the voice mailbox owner is a subscriber to a voice mail notification service."

The Examiner alleges inherent disclosure of this claim element in Cruickshank. (Office Action, page 3 (citing Cruickshank ¶ 29, lines 1-8).) Applicants respectfully disagree. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." (Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (emphasis added); M.P.E.P. § 2131.01 (III) (8th Ed., Rev. 2, May 2004).)

-8-

Customer No. 32,127
Attorney Docket No. 01-1001

Cruickshank is generally directed to a voice messaging server from which voice messages may be downloaded. Cruickshank, Abstract. Cruickshank further discloses a voice messaging server (102), which, upon arrival of a new voice message for the user of handheld (114B), sends an indication to a user of handheld 114B that a new voice message has arrived. (Cruickshank, ¶ 29.) Thus, in the system described in Cruickshank, a user automatically receives indication of a new voice message – there is no need to determine whether a voice mailbox owner is a subscriber to the notification service, and Cruickshank provides no description of making any determination of whether a voice mailbox owner is a subscriber to the notification service. Without the necessity to make such a determination, such a determination cannot be inherently present in the system described in Cruickshank.

Because the missing descriptive matter is not necessarily present in the system described in Cruickshank, Cruickshank fails to disclose, inherently or otherwise, every claim element. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 7 under section 102(e).

C.   Rejections Under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. (M.P.E.P. § 2143.03 (8th Ed., Rev. 2, May 2004).) Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in applicant's disclosure." (M.P.E.P. § 2143 (8th Ed., Rev. 2, May 2004).)

a. Claims 1-3, 5, 22, and 23

Applicants respectfully traverse the rejection of claims 1-3, 5, 22, and 23 under 35 U.S.C. § 103(a) as unpatentable over Cruickshank in view of Bernnan. No *prima facie* case of obviousness has been established with respect to claims 1-3, 5, 22, and

-9-

23 for at least the reason that Cruickshank, taken alone or in combination with Bernnan, does not teach or suggest each and every element recited in the claims.

For example, claim 1 recites, among other things:

> receiving a first message from an SCP in the telephone network at the at least one gateway device, the first message including an identifier of the calling party and the voice mail message;
> accessing a profile associated with the called party to identify a selected one of a plurality of instant messaging identifiers associated with the called party, the selected instant messaging identifier being selected based on rules for communication forwarding; and
> providing a second message in an instant messaging format including the calling party identifier and the voice mail message using the selected instant messaging identifier to the user terminal of the called party via the data network.

Cruickshank discloses a configuration of a system for providing an indication of a new voice message to a user via an instant messaging server. (Cruickshank, ¶ 29.) However, the configuration described in Cruickshank simply provides the indication to a handheld (114B), (Cruickshank, ¶¶ 15, 29), and does not "[access] a profile associated with the called party to identify a selected one of a plurality of instant messaging identifiers associated with the called party, the selected instant messaging identifier being selected based on rules for communication forwarding," as recited in claim 1.

Bernnan, relied on for its disclosure of an SCP, fails to cure the deficiency of Cruickshank. Bernnan discloses a database (50) in Figure 3, which stores a called party's user information, such as voice mail address, mobile phone address, e-mail address, Internet instant messaging address, etc., as well as types of messages that may be received at each address. (Bernnan, ¶ 42.) However, the information in the database (50) is used to ensure data compatibility between the calling party's device and the called party's device, (Bernnan, ¶ 44), not "to identify a selected one of a plurality of instant messaging identifiers associated with the called party, the selected instant messaging identifier being selected based on rules for communication forwarding," as recited in claim 1.

-10-

Since neither Cruickshank nor Bernnan teach or suggest all of the elements of claim 1, Applicants respectfully request that the Examiner withdraw the rejection of claim 1. As claims 2-3, 5, 22, and 23 depend from claim 1, Applicants believe claims 2-3, 5, 22, and 23 to be patentable over Cruickshank and/or Bernnan for at least the same reasons as noted for claim 1,[2] and therefore respectfully request that the rejections of claims 2-3, 5, 22, and 23 be withdrawn as well.

b. Claims 8-11

Applicants respectfully traverse the rejection of claims 8-11 under 35 U.S.C. § 103(a) as unpatentable over Cruickshank in view of Bernnan. No *prima facie* case of obviousness has been established with respect to claims 8-11 for at least the reason that Cruickshank, taken alone or in combination with Bernnan, does not teach or suggest each and every element recited in the claims.

For example, claim 8 recites, among other things: "accessing a profile associated with the user to identify communication forwarding rules," and "notifying the user of the stored voice mail via the data network based on the communication forwarding rules."

As noted above with respect to claim 1, the system described in Cruickshank simply provides an indication of a new voice message to a user's handheld (114B), (Cruickshank, ¶¶ 15, 29), and does not "[access] a profile associated with the user to identify communication forwarding rules . . . and [notify] the user of the stored voice mail via the data network based on the communication forwarding rules," as recited in claim 8.

Bernnan, relied on by the Examiner for its disclosure of storing a voice mail in a telephone network and an SCP, fails to cure the deficiencies of Cruickshank. As noted above for claim 1, the system described in Bernnan uses information associated with a user to ensure data compatibility between the calling party's device and the called party's device when sending a message. (Bernnan, ¶ 44.) There is no description in

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[2] As Applicants' remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejections of all claims dependent therefrom, Applicants' silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicants to the Examiner's assertions as to these claims, and Applicants reserve the right to analyze and dispute such assertions in the future.

Bernnan of either "accessing a profile associated with the user to identify communication forwarding rules," or "notifying the user of the stored voice mail via the data network based on the communication forwarding rules," as recited in claim 8.

Since neither Cruickshank nor Bernnan teach or suggest all of the elements of claim 8, Applicants respectfully request that the Examiner withdraw the rejection of claim 8. As claims 9-11 depend from claim 8, Applicants believe claims 9-11 to be patentable over Cruickshank and/or Bernnan for at least the same reasons as noted for claim 8, and therefore respectfully request that the rejections of claims 9-11 be withdrawn as well.

c. Claims 12, 16 and 17

Applicants respectfully traverse the rejection of claims 12, 16 and 17 under 35 U.S.C. § 103(a) as unpatentable over Cruickshank in view of Bernnan. No *prima facie* case of obviousness has been established with respect to claims 12, 16 and 17 for at least the reason that Cruickshank, taken alone or in combination with Bernnan, does not teach or suggest each and every element recited in the claims.

For example, claim 12 recites, among other things: "a gateway device, connected to both the telephone network and the data network, configured to . . . access a profile associated with the called party to identify called party communication forwarding rules; and provide a second message . . . to the called party via the data network based on the called party communication forwarding rules."

As noted above with respect to claims 1 and 8, the system described in Cruickshank simply provides an indication of a new voice message to a user's handheld (114B), (Cruickshank, ¶ ¶15, 29), and does not include a gateway device configured to "access a profile associated with the called party to identify called party communication forwarding rules" or "provide a second message . . . to the called party via the data network based on the called party communication forwarding rules," as recited in claim 12.

Bernnan, relied on by the Examiner for its disclosure of storing a voice mail in a telephone network and an SCP, fails to cure the deficiencies of Cruickshank. As noted above, the system described in Bernnan uses information associated with a user to ensure data compatibility between the calling party's device and the called party's

device when sending a message. (Bernnan, ¶ 44.) There is no description in Bernnan of a gateway device configured to "access a profile associated with the called party to identify called party communication forwarding rules" or "provide a second message . . . to the called party via the data network based on the called party communication forwarding rules," as recited in claim 12.

Since neither Cruickshank nor Bernnan teach or suggest all of the elements of claim 12, Applicants respectfully request that the Examiner withdraw the rejection of claim 12. As claims 16 and 17 depend from claim 12, Applicants believe claims 16 and 17 to be patentable over Cruickshank and/or Bernnan for at least the same reasons as noted for claim 12, and therefore respectfully request that the rejections of claims 16 and 17 be withdrawn as well.

d. Claims 24 and 25

Applicants respectfully traverse the rejection of claims 24 and 25 under 35 U.S.C. § 103(a) as unpatentable over Bernnan in view of Cruickshank. For example, claim 24 recites, among other things: "a management server connected to the voice mail notification server, and configured to provide communication forwarding rules associated with the called party; wherein, upon receipt of the voice mail in the voice network . . . the data interface server forwards the second message in IP format to the user terminal based on the communication forwarding rules provided by the management server."

Bernnan is generally directed to a method and system for permitting a caller to compose and send a message if the call cannot go through due to a busy signal, no answer, or other reasons. (Bernnan, Abstract.) In the system of Bernnan, "[o]nce the calling party completes composing the voice mail message, the supervisory system (20) sends the voice mail message to the called party voice mail address (S216)." Other variations are also described, such as periodic redialing, (Bernnan, ¶ 29), and generating a forward-no answer message (Bernnan, ¶ 30.) However, nothing in the disclosure of Bernnan teaches or suggests "[forwarding] [a] message in IP format to [a] user terminal based on the communication forwarding rules provided by [a] management server," as claimed.

Cruickshank is relied on by the Examiner for its disclosure of a data interface server and a voice mail notification server. However, Cruickshank does not teach or suggest at least the claimed elements noted above and, therefore, fails to cure the deficiencies of Bernnan.

Since neither Cruickshank nor Berman teach or suggest all of the elements of claim 24, Applicants respectfully request that the Examiner withdraw the rejection of claim 24. As claim 25 depends from claim 24, Applicants believe claim 24 to be patentable over Cruickshank and/or Berman for at least the same reasons as noted for claim 24, and therefore respectfully request that the rejection of claim 25 be withdrawn as well.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and Applicant requests that the Examiner pass this application to issue. If there are any outstanding issues which need to be resolved to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned representative by phone at the number indicated below to discuss such issues. Please charge any deficiencies in fees to patent office deposit account number 07-2347. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged against this account.

Respectfully submitted,

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